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AStadnicki@antonelli.com
alfred.a.stadnicki@gmail.com
dprater@antonelli.com



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/619,186
Filing Date: July 15, 2003
Appellant(s): TOYODA, HIROBUMI

Alfred A. Stadnicki
Reg. No. 30,226
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 25th, 2008 appealing from the Office action mailed December 13th, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,980,384 Barrie 11-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

All of the said claims seem narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. The examiner cannot understand or grasp the main idea within the many limitations of the claims.

Claims 13-16, states “ The gaming machine according to Claim 1, further comprising: a prior cell effective means for making at least one of the cells of the matrix

effective based on effective cell lottery." wherein the examiner cannot comprehend limitations the claims is trying to make. Wherein the examiner cannot follow what is meant by "making atleast one of the cells of the matrix effective based on effective cell lottery." Examiner does not follow what the applicant means by the term effective? Thus all of the claims are given broadest reasonable claim interpretation, and the examiner interprets this claims as a means for selecting one of the cell.

The stated claims language above is just an example of indefinite claim language through out the claims. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barrie (US Patent 5,980,384).

Claims 1 & 3: Barrie teaches of a combination making gaming machine (slot machine), wherein symbols are allocated to each cell on a multi-cell gaming machine, wherein the symbol is selected randomly (col. 4: 29-43), and an award is provided to the player based on the combination of the symbols in the cells (col. 4: 12-28). The game machine consists of a number generator that randomly places a symbol into each cell of the machine (col. 4: 29-43, col. 1: 29-35). Barrie also teaches of shifting symbols from

original cell to an adjacent cell position (col. 4: 52-68, wherein the symbol shift occurs randomly, i.e. the selection is picked by a random number generator which is same as a lottery generator, [wherein the second embodiment allows for all of the symbols having capabilities of moving from their original position to an adjacent position, col. 12: 36-55]). Barrie also teaches of an award determination means, which determines the award, and disburses, to the player if any combination of symbols is achieved after the occurrence of the shift (col. 6: 13-23). Barrie however fails to teach that the symbols are poker symbols. However at the time the invention was made, it would have been obvious matter of design choice to a person of ordinarily skill in the art to display poker symbols on a slot machine, instead of conventional fruits symbols as taught by Barrie, thus increasing player involvement and further increasing player entertainment.

Claims 2 & 4: Barrie teaches of shifting symbols from an original position to a secondary position (fig 2, wherein the symbol could be shifted between an inner group or an outer group).

Claims 5-8: Barrie teaches of multiple paylines, which are player selectable (col. 6: 24-28). Barrie also teaches of obtaining winning combination after the symbols have been allocated and determining that the benefits provided to the players in the bonus round or after the symbol allocation is higher than standard payout (col. 4: 52-68 and figure 2 and the description thereof).

Claims 9-12: Barrie teaches of a combination recognition means, which determines if the combination on the screen results in an award, and if so then provides an award to the player (col. 4: 12-28).

Claims 13-16: Barrie teaches of a prior cell effective means for making on of the cells of the matrix in accordance with an effective lottery (col. 6: 13-23).

Claim 17: Barrie teaches a gaming machine adapted to perform a combination game using a square matrix, which contains a plurality of cells (figure 1 and col. 8: 19-24). Barrie also teaches of allocating symbols to each cell on a multi-cell gaming machine, wherein the symbol is selected randomly (col. 4: 29-43), and an award is provided to the player based on the combination of the symbols in the cells (col. 4: 12-28). The game machine consists of a number generator that randomly places a symbol into each cell of the machine (col. 4: 29-43, col. 1: 29-35). Barrie also teaches of shifting symbols from original cell to an adjacent cell position (col. 4: 52-68, wherein the symbol shift occurs randomly, i.e. the selection is picked by a random number generator which is same as a lottery generator [wherein the second embodiment allows for all of the symbols having capabilities of moving from their original position to an adjacent position col. 12: 36-55]). Barrie also teaches of an award determination means, which determines the award, and disburses, to the player if any combination of symbols is achieved after the occurrence of the shift (col. 6: 13-23).

Claim 18: Barrie teaches of shifting symbols from an original position to a secondary position (fig 2, wherein the symbol could be shifted between an inner group or an outer group).

Claims 19-20: Barrie teaches of an article of manufacture comprising a program stored on a medium for use in a gaming machine (col. 11: 39-68), to perform a combination game using a square matrix, which contains a plurality of cells (figure 1 and

col. 8: 19-24). Barrie also teaches of allocating symbols to each cell on a multi-cell gaming machine, wherein the symbol is selected randomly (col. 4: 29-43), and an award is provided to the player based on the combination of the symbols in the cells (col. 4: 12-28). The game machine consists of a number generator that randomly places a symbol into each cell of the machine (col. 4: 29-43, col. 1: 29-35). Barrie also teaches of shifting symbols from original cell to an adjacent cell position (col. 4: 52-68, wherein the symbol shift occurs randomly, i.e. the selection is picked by a random number generator which is same as a lottery generator, [wherein the second embodiment allows for all of the symbols having capabilities of moving from their original position to an adjacent position col. 12: 36-55]). Barrie also teaches of an award determination means, which determines the award, and disburses, to the player if any combination of symbols is achieved after the occurrence of the shift (col. 6: 13-23).

Claims 21-22: Barrie teaches the gaming machine having a square five-by-five matrix (col. 8: 19-23). Barrie however fails to teach that the symbols are poker symbols and the winning hand is a winning poker hand. However at the time the invention was made, it would have been obvious matter of design choice to a person of ordinarily skill in the art to change the display of the game from different fruit display as taught by Barrie to different poker symbols or Mahjong tiles, thus allowing player to obtain winning combination in poker hands or Mahjong hands and increasing player involvement and further increasing player entertainment.

Claims 23-27: Barrie teaches of a combination making gaming machine (slot machine), wherein symbols are allocated to each cell on a multi-cell gaming

machine, wherein the symbol is selected randomly (col. 4: 29-43), and an award is provided to the player based on the combination of the symbols in the cells (col. 4: 12-28). The game machine consists of a number generator that randomly places a symbol into each cell of the machine (col. 4: 29-43, col. 1: 29-35). Barrie also teaches of shifting symbols from original cell to an adjacent cell position (col. 4: 52-68, wherein the symbol shift occurs randomly, i.e. the selection is picked by a random number generator which is same as a lottery generator). Barrie also teaches of an award determination means, which determines the award, and disburses, to the player if any combination of symbols is achieved after the occurrence of the shift (col. 6: 13-23). Barrie however fails to teach that the symbols are poker symbols. However at the time the invention was made, it would have been obvious matter of design choice to a person of ordinarily skill in the art to display poker symbols on a slot machine, instead of conventional fruits symbols as taught by Barrie, thus increasing player involvement and further increasing player entertainment.

(10) Response to Argument

In response to appellant's arguments that the rejection of claims 13-16 rejected under 35 U.S.C 112, 2nd paragraph, not being asserted prior to the final office action, the examiner would like to reiterate that the rejection of claims 13-16 under 35 U.S.C 112, 2nd paragraph was permitted due to the amendments made by the appellant submitted September 26th, 2007, wherein the appellant had amended claims 1-20 (The

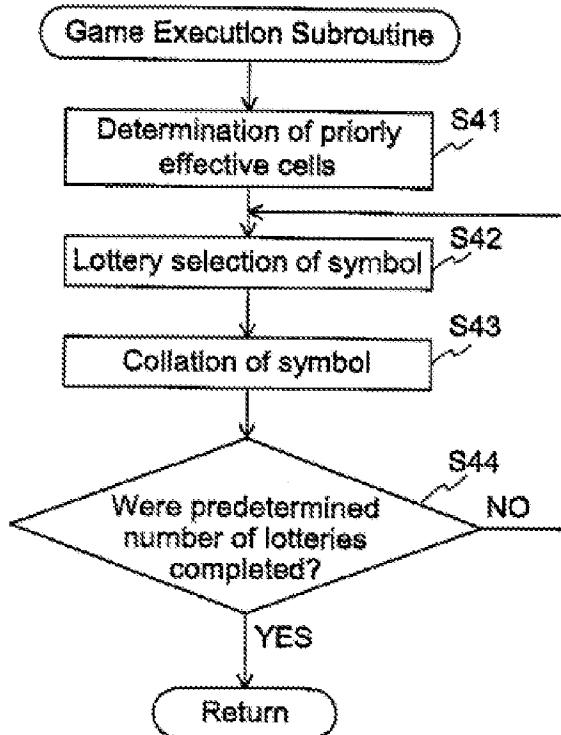
Art Unit: 3714

examine would also like to point out that the rejection with regards to 35 U.S.C 112, 2nd paragraph, was justified in the Advisory Action mailed on April 23, 2008).

With regards to the appellant's arguments that details of features claimed in claims 13-16 are described on page 69, first full paragraph with reference figure 17 of the specification, the examiner respectfully disagrees with the appellant. Page 69 of the specification, especially first paragraph of the said page states:

First in the process of step S41, the determination of priorly effective cells is performed. In this process, CPU 66 performs a lottery for determining cells, among the twenty-five cells of the matrix card, that are to be effective from the start of the game. CPU 66 performs a lottery regarding the number and positions of the cells to be made effective, and based on this result, makes effective the cells that are to be made effective. When this process is ended, a transfer to step S42 is performed.

Fig. 17



However neither the specification nor the figure which is being described in the selected passage of the specification help one with ordinary skill in the art comprehend meaning and scope of said claims. The examiner would also like to point out that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to appellant's arguments that examiner has failed to provide a persuasive explanation why a person of ordinary skill in the art would have reason to modify the prior art, thus fail to establish a *prima facie* case of obviousness. The examiner respectfully disagrees with the appellant. First and foremost the examiner

would like to reiterate that all claims are given broadest reasonable claim interpretation. With regards to appellant submitted claims, the appellant claims; a symbol allocating means to allocate symbols to each cell of a matrix, wherein the symbols are selected from a deck of playing cards; a cell shifting means wherein said allocated symbols are shifted from an original position to an adjacent position; a disbursement value determination means for disbursement depending on the combination ranking of the winning symbol combination. As stated by the examiner in the rejection above, Barrie teaches of a symbol allocating means for allocating random symbols to each of the cell of the matrix; shifting the said allocated symbols from an original position to an adjacent position; and providing player with an award or disbursement if the shifted symbols create a winning symbol combination, wherein different symbol combination has different winnings associated with it. However Barrie does not teach of symbol being selected from a deck of playing card, but teaches of different fruits symbols, however having symbols not resemble a deck of cards does not preclude the game from performing differently than claimed, thus it would be obvious for one in the ordinary skill in the art to modify the gaming machine to display symbols that are not symbols of playing cards, because the symbol holds no barrier on the outcome of the game, thus would establish a *prima facie* case of obviousness.

In response to appellant's arguments, the recitation that Barrie lacks symbol allocation to be made through allocation of symbol my means of effective lottery, has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the

purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Appellant also argues that Barrie fails to teach or suggest a disbursement based on the cells along a line having winning combination and having been made effective by lottery after shifting symbols. The examiner respectfully disagrees with the Appellant. As stated above in the rejection, Barrie teaches of a game machine consists of a number generator that randomly places a symbol into each cell of the machine (col. 4: 29-43, col. 1: 29-35, wherein a random number generator is an art equivalent of a lottery generator, since both utilize the same technique of picking random numbers from a pool of available numbers). Barrie also teaches of shifting symbols from original cell to an adjacent cell position (col. 4: 52-68, wherein the symbol shift occurs randomly, i.e. the selection is picked by a random number generator which is an art equivalent of a lottery generator). Barrie also teaches of an award determination means, which determines the award, and disburses, to the player if any combination of symbols is achieved after the occurrence of the shift (col. 6: 13-23).

With regards to appellant's arguments that Barrie lacks any disclosure of shifting symbols allocated to the cell of a matrix, the examiner respectfully disagrees with the appellant's arguments. As stated in the rejection above, one of the embodiments of Barrie allows for the symbols from the initial set of the matrix to be replaced by another

symbol from the same matrix, consequently the symbols will be shifted from their original position to a new position. Hence Barrie allows for shifting of the symbols.

Regarding the appellant's arguments that shifting of the symbol disclosed by Barrie is a shifting between two different games, the examiner disagrees with the appellant's assessment of Barrie. Barrie teaches of have two rounds, which are dependent upon each other of the SAME GAME (base game and bonus round). Barrie allows for the player to play the base game and evaluate the outcome of the base game, if base game triggers a bonus activation, bonus game is then executed, wherein in a bonus play of the same game, a bonus symbols appears which allows for symbols to be shifted from their original position to an adjacent position, thus creating an additional opportunity for the player to increase his/her winning. However at no point does the game end and a new game began as stated by the appellant, instead the bonus play is continuation of the base game.

Regarding the appellant's arguments that Barrie lacks teaching of shifting each symbol from an original cell position to an adjacent position. The examiner respectfully disagrees with the appellant. As stated above in the rejection, Barrie in the second embodiment allows for all of the symbols having capabilities of moving from their original position to an adjacent position (see col. 12: 36-55)

With regards to the appellant's arguments related to the dependent claims 2, 4 & 18, that no reasoning has been provided in the rejection, the examiner respectfully disagrees with appellant, and the rejection above does provide a reasonable explanation with regards to all of the limitations claimed by the claim language.

With regards to the appellant's arguments related to dependent claims 5-8 & 24, the examiner would like to point out that all claims have been given their broadest reasonable claim interpretation, and the rejection is made in light of the said interpretation. The examiner would also like to point to the rejection above and would like to mention that all of the claimed limitations have been addressed in the said rejection.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Sunit Pandya/

Patent Examiner, Art Unit 3714

Conferees:

/Scott E. Jones/

Primary Examiner, Art Unit 3714

/John M Hotaling II/

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Supervisory Patent Examiner, Art Unit 3714